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10/091,591	03/07/2002	Raymond J. Bergeron	T2315-907789	9684

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Miles & Stockbridge
1751 Pinnacle Drive, Suite 500
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EXAMINER

COOK, REBECCA

ART UNIT	PAPER NUMBER
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1614

12

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 10/091,591
Filing Date: March 07, 2002
Appellant(s): BERGERON, RAYMOND J.

MAILED
AUG 7 2003
GROUP 2900

Dennis P. Clarke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed may 28, 2003.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-7 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by 5,962,533. '533 discloses compositions (column 3, lines 59-60) comprising the instant compound (column 4, Table 1, compounds 33 and 34) and that they are used to treat diarrhea. Table 1, compounds 33-34 disclose a compound in which Q is a cyclohexyl group connected as the trans isomer, R1 and R4 are CH₂CH₃, R2 and R3 are H and x and y are 4. This corresponds to the compound of the composition of claims 1, 2, 3 and 7 in which R1 and R4 are alkyl, R2 and R3 are H, Q is a cyclohexyl group connected as the trans isomer and x and y are 4.

It is noted that appellant has not argued the specific limitations of dependent claims 4-6. Furthermore, he recites on page 3 of the Brief that "The appealed claims stand or fall together."

CA125:25633 is considered cumulative and is no longer applied.

(11) Response to Argument

Appellant argues that the only pharmaceutical compositions for the treatment of diarrhea disclosed by '533 contain at least one CH(OH) group in at least one of the bridging groups. He further argues that he is not claiming a pharmaceutical composition

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for the treatment of diarrhea containing a polyamine which contains at least one CH(OH) group in at least one of the bridging groups.

This is not persuasive. Instant claim 1 recites a "...composition comprising... an effective amount of a compound..." The instant comprising language is open-ended and does not exclude the CH(OH) group of '533.

Appellant argues that while compounds 33 and 34 are embraced by the structural formulae of the rejected claims, there is no disclosure in the reference of pharmaceutical compositions suitable for the treatment of diarrhea that contains either compound 33 or 34. This is not persuasive.

5,962,533 discloses (column 3, lines 59-60) that the compounds listed within can be used in pharmaceutical compositions. The fact that compounds 33 and 34 are not disclosed as having anti-diarrheal properties does not remove them as references. It is well-established that intended use does not impart patentability in a composition claim.

Appellant's arguments regarding the J. Med. Chem. Article are moot, since it is no longer applied.

Appellant argues that US Patent No. 6,399,662 contains claims drawn to methods of treating diarrhea by administering to patients in need thereof the same polyamines described in the present claims and issued in spite of the fact that US patent no. 5,962,523 was cited there against. This is not persuasive since '662 is to a method of use, whereas the instant claims are to a composition. Again, intended use does not impart patentability to a composition claim.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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Art Unit 1614

RC
July 31, 2003

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SPE/1617